

Remarks

This is intended to be a complete response to the Official Action mailed April 21, 2006, in which claims 83-86, 88, 95-98, 101, 104, 107-115, 117, 120-125, 127, 128, and 132-135 were rejected and claim 136-183 were withdrawn from further consideration and are hereby cancelled.

Claims 83, 95, 111, and 121 have been amended herein. New dependant claims 184-195 which depend from claims 83, 95, 111 and 121 have been added. Amended claims 108 and 110, and new claims 188 and 190 reference an alkyl polysiloxane, which is supported in ¶ 19, page 7 of the original specification. New claims 192-195 are supported in ¶ 20, page 8 of the original specification.

Applicant's agent appreciates the courtesies extended by the Examiner during the personal interview on August 29, 2006 during which various potential amendments for overcoming the rejections over the prior art were discussed. The amendments and remarks made herein are reflective of the discussions therein.

Rejections under 35 U.S.C. §102(b)

Claims 83-84, 88, 95-96, 101, 104, 107-112, 115, 117, 120-122, 125, 127-128, and 132-135 stand rejected under 35 U.S.C. §102(b) as being anticipated by Badesha et al. (U.S. Patent No. 4,855,201).

Applicant respectfully traverses the rejection in view of the amendments made herein.

The Badesha et al., reference teaches applying a thin layer of a silicon or polysiloxane material to a surface using a "Bird" applicator, which has a narrow milled portion which spreads the material in a consistent layer over the surface.

In the present claims, the applicator device, as shown in Figure 7 and discussed on page 8, ¶ [0021] and page 14, ¶ [0033], is defined as having a body, a reservoir comprising a transparent composition, and an applicator end which has an absorbent material on a portion thereof which contracts the analytic plate to apply the transparent composition to the slide by appressing the applicator end to the analytic plate such that there is no gap therebetween and wherein.

A typical "Bird" applicator is constructed of a hard metal. The "applicator end" of the Bird applicator is essentially just a gap portion of one side of the Bird applicator which is formed by milling.

In the rejection it is stated:

"The court decided In re Larson (144 USPQ 347) the use of a one piece construction instead of a device made from different components would have been a matter of obvious engineering choice. It would have been desirable to make the elements of the Bird application that are not contracting the surface out of less expensive, light weight materials, such as plastic. It would have been within the skill of the art to modify Badesha et al. and make the non-surface contacting portion of the Bird applicator out of a less expensive and light weight materials, such as plastic, as a matter of obvious engineering design choice."

The Declaration of Lee Angros submitted herewith provides evidence which demonstrates that, contrary to the Examiner's assertion, a person of ordinary skill in the art would not construct a Bird-type applicator to have an applicator end made with an absorbent material as claimed herein.

In particular, in the Declaration it is stated:

As shown in Attachments 1-4 obtained from various manufactures of Bird applicators, Bird-type applicators are constructed from metals such as stainless steel (with or without a nickel chrome finish) or aluminum. Bird-type applicators are designed to be "precision" devices which apply films having uniform thickness of as low as 12.5 μm (half of the smallest gap size of 25 μm ; See Attachment 4).

As clearly indicated by the descriptions of Bird-type applicators given in Attachments 1-4, the Bird-type applicator is a tool which is "machined to a fine tolerance" (see Attachment 1). These tools would be useless for their intended purpose (to apply a uniform layer) if they were constructed of a material which could not maintain "precision" and "a fine tolerance" over repeated usage.

It is also obvious that a person of ordinary skill in the art of manufacturing Bird-type applicators would not manufacture one from a material which (1) could not provide a film layer of uniform thickness and (2) could not withstand repeated uses without being subjected to damage, such as nicks. In fact, it is apparent that if the applicator end ("gap end") of the Bird-applicator as made with an "absorbent material" as claimed in my application, it would very likely be eventually damaged (e.g., nicked, torn, ripped, worn) and moreover would not apply a uniform thickness as is sought by users of Bird-type applicators.

In view of the Declaration of Lee Angros and the attachments provided therewith, it is obvious that a person of ordinary skill in the art would not modify a Bird-type applicator as asserted in the official action.

Further, in the present claims, it is indicated that the apparatus has a body which has a reservoir which contains a composition for application to a slide. As shown in the Attachments to the Declaration, Bird-type applicators do not have reservoirs.

Further, as indicated in the Attachments to the Declaration, the “applying portion” (i.e., the gap) of the Bird-type applicator is not appressed to the surface as is claimed in the present invention. In the Bird-type applicator, a gap is maintained between the surface and the applying portion of the device, thus the actual “applicator end” of the Bird application does not touch the surface.

In view of the above, it is clear that the present invention is neither anticipated by nor *prima facie* obvious over the Badesha et al. reference. Applicant respectfully requests reconsideration and withdrawal of the rejection.

Rejection under §103(a)

Claims 83-86, 88, 95-98, 101, 104, 107-115, 117, 120-125, 127-128, and 132-135 stand rejected under 35 U.S.C. §103(a) as being obvious over Yanus et al. (U.S. Patent No. 4,521,621).

The Yanus et al. reference provides essentially the same teachings as Badesha et al. regarding Bird-type applicators. Applicant traverses the rejection under Yanus et al. for the same reasons provided in response to the rejection under Badesha et al. and incorporates those remarks herein.

In view of the above, Applicant respectfully submits the claims are not *prima facie* obvious over Yanus et al., and respectfully request withdrawal of the rejection under 35 U.S.C. §103(a).

Conclusion

In view of the above, Applicant respectfully submits the claims are novel and unobvious over the cited art, and requests reconsideration of the rejections under 35 U.S.C. §102 and 103, and issuance of a Notice of Allowance therefor.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Christopher W. Corbett', is written over a horizontal line.

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